

the patent holder must be fully aware of prior art (that was not disclosed in the initial application) that clearly indicates the existence of other field bean materials that have equivalent characteristics to those claimed by the patent holder.

The lengthy discussion of genetic transformation technology again does nothing to address the issues raised by the examiner.

Claims Rejections 35 U.S.C. Section 112, 2<sup>nd</sup> Para

It is respectfully submitted that patent holder has not "fully responded" to the directions of the examiner with respect to claims 7,9,10, and 56. This matter is addressed in the earlier comments on currently amended claims.

Claim Rejections 35 U.S.C. Sections 102/103

The examiners position is not fundamentally flawed. The patent owner is not under the obligation to acquire such beans, but is required to ensure that published prior art does not preclude the claims of his invention. Such published prior art, was not disclosed in the original application, but is readily available to those skilled in the art. The patent holder seeks again to distort and cloud this matter by indicating that there is now some requirement to acquire and test these materials against his own claims. The United States Plant Variety Protection Office does not perform such comparative trials prior to reaching its decisions; it does however rely on published data concerning such accessions.

The ensuing recitation regarding the contact that patent holder has had with CIAT and its attorney representative is again very disingenuous and moves the discussion from the strict legal standard. The published data on these materials has been publicly available for years; it is legitimate prior art against the claims, irrespective of the physical ownership of the material. As a matter of record however, it is a lengthy and complex process to ship internationally the requested CIAT bean accessions. These delays are due to quarantine requirements and the volume of requests handled by CIAT. As patent holder must be aware CIAT holds these accessions "in trust" under an agreement with the Food & Agriculture Organization of the United Nations (FAO), and distributes tens of thousands of samples annually to over 100 countries. Seeds requested in October 2002 by Mr. Proctor were shipped in March of 2003. This falls well within the norms of seed shipment from CIAT to other organizations.

Furthermore, allegations of "arm waiving" are inappropriate to a multinational organization that is co-sponsored by FAO, the United Nations Development Program and the World Bank. CIAT is a highly professional organization using its statutory right to seek re-examination of an erroneously issued patent that impacts on CIAT and its National Program Partners in the developing world. CIAT in its re-examination request raised legitimate issues, which is why the process was approved and is underway.

The examiner is not "requiring patent holder to study beans in the possession of CIAT", rather the examiner is requesting patent holder to show why its claimed inventions are not

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covered by the prior art already fully and adequately published by CIAT and others. That published data fully discloses the color analyses of the disclosed accessions by CIAT. The current position seems to fall into the same shortcoming as the original application, that is, the information is there, but patent holder does not choose to look at it, or more importantly cite it.

The principle reason for this letter is to address the allegation on Page 14 of patent holders response to the office action where he makes the comment "it appears that the CIAT allegations are inequitable". My client cannot, and will not let this type of language stand. According to the legal dictionary definition Equity is "justice according to fairness". Is it fair that:

- (1) A patent application is submitted that does not disclose existing materials held by an organization that holds a global mandate for phaseolus bean improvement.
- (2) A patent is exercised that claims all yellow phaseolus beans that thus serves to prevent developing countries from exporting their products, that have been grown for years before the patent was applied for, into the United States.
- (3) A patent is exercised that prevents US bean growers from growing yellow bean materials that they have grown for years before the patent petition was submitted.
- (4) That because of repeated change in counsel this re-examination has drawn on for more than 2 years, during which time patent holder has continued to exercise the rights outlined above.

We would contend that inequity is not a term appropriately addressed to this side of the dispute in question.

#### Information Assessment / Requirement for Information

The declaration as to the conditions under which the original seeds were acquired and "developed" into Enola does not address many concerns that have been previously drawn to the examiners attention. There is material inconsistency between the description given in the patent as issued, sworn depositions given in litigation involving the Enola material, and the current declaration.

It is also very surprising that Mr. Proctor states that previous to the acquisition he "had never seen yellow beans either in Mexico or the United States". Again to a person skilled in the art a great deal of information and materials were available at that time as witnessed by publications provided as prior art in the re-examination request, and by statements from the bean improvement community in the United States, through letters of testimony provided with the re-examination request.

**In relation to prior sale in the United States of materials having the same claimed properties as Enola (ie sold at retail level, sold under a different name) it is an evasive answer for patent holder to provide. CIAT again draws the attention of the examiner to written evidence provided that shows that yellow beans were sold more than one year prior to the patent petition of materials that have been identified by**

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others as "indistinguishable from Enola". This should therefore serve as a statutory bar to the patent.

The comment that arguments and evidence relating to prior public sale were complex and convoluted in recently settled litigation speaks volumes. Given that this matter is highly pertinent to the validity of the entire patent it is unfortunate that patent holder chose "not to address those arguments and evidence here". Offers to "answer any further questions the examiner has on this topic" is an attempt to seek further delay, (I believed this was the final action) and thus allow the patent holder to continue to exercise his rights over a clearly erroneous patent.

Closing Remarks

These comments are offered to the examiner, with copy to patent holder, at the specific request of my client.

The outcome of this re-examination is being closely observed not only by the patent holder, but also by small farmers, NGO's, bean growers, the academic community and members of the intellectual property profession both in the United States and beyond. There is a need for balanced judgment and equity, and an upholding of the laws and principles upon which patent laws are based. On behalf of my client I wish the examiner well in the continued deliberations and decisions on this important matter.

Yours truly

  
Dr. John Dodds  
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It is hereby certified that a copy of this letter was mailed first class on April 3, 2003

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